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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,698	03/04/2002	Joseph Murray	AGYT-011CIP2	5398

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EXAMINER

KIM, YOUNG J

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary**Application No.**

10/090,698

Applicant(s)

MURRAY ET AL.

Examiner

Young J. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action responds the Amendment received on March 26, 2004.

Priority

Applicants' statement regarding the priority is noted. Applicants indicate that the reference to the prior-filed applications in the specification have been deleted as well as the submission of a substitute ADS in which the previously cited priority claims are deleted (page 6, 3rd paragraph). No ADS was received. Therefore, the priority information contains in the ADS received on August 26, 2002 is in effect.

Additionally, Applicants are advised that if the priority claim is deleted from the specification as well as in a new ADS, the instant application would be subject to prior art which antedate the filing date of only the instant application.

Claim Objections

The objection of claims 16 and 20 for missing a punctuation and conjunction, made in the Office Action mailed on January 2, 2004, is withdrawn in view of the Amendment received on March 26, 2004.

Claim Rejections - 35 USC § 112

The rejection of claims 1-15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, made in the Office Action mailed on January 2, 2004, is withdrawn in view of the Amendment received on March 26, 2004.

Claim Rejections - 35 USC § 102

The rejection of claims 16-20 under 35 U.S.C. 102(b) as being anticipated by Koza et al. (U.S. Patent No. 5,390,282, issued February 14, 1997), made in the Office Action mailed on January 2, 2004, is withdrawn in view of the Amendment received on March 26, 2004.

Claim Rejections - 35 USC § 103

The rejection of claims 1-3, 5-10, 14, 16-18, and 20 under 35 U.S.C. 103(a) as being unpatentable over Eisen et al. (PNAS, 1998, vol. 95, pages 14863-14868; IDS reference) in view of Andrade et al. (Bioinformatics, 1998, vol. 14, no. 7, pages 600-607; IDS reference) and Cocks et al. (U.S. Patent No. 6,607,879 B1, issued August 19, 2003, filed February 9, 1998), made in the Office Action mailed on January 2, 2004, is withdrawn in view of the Amendment received on March 26, 2004.

The rejection of claims 1, 4, 11-13, 16-18, and 20 under 35 U.S.C. 103(a) as being unpatentable over Eisen et al. (PNAS, 1998, vol. 95, pages 14863-14868; IDS reference) in view of Ng et al. (Genome Informatics, 1999, vol. 10, pages 104-112; IDS reference) and Cocks et al. (U.S. Patent No. 6,607,879 B1, issued August 19, 2003, filed February 9, 1998), made in the Office Action mailed on January 2, 2004, is withdrawn in view of the Amendment received on March 26, 2004.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,470,277 B1 (hereto referred to as '277 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of claims 1-14 of the instant application is, while different in wording, drawn to the same invention as that covered by claims 1-10 of the '277 patent in that both of the methods are computer implemented method which identifies a candidate genes via searching a group of databases, extracting annotative information for the retrieved genes, followed by the assignment of the reference (or publication as in the instant claims) score to the extracted annotative information for the determination of the candidate gene.

For the above reasons, instant claims 1-14 are obvious over claims 1-10 of the '277 patent.

Claims 16, 17, and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-20 and 28-47 of copending Application No. 10/229,912 (hereto referred to as '912 application; its USPGP

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provided). Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of claims 16, 17, and 20 of the instant application is, while different in wording, drawn to the same invention as that covered by claims 14-20 and 28-47 of the '912 application in that both of the systems identifies a candidate genes via searching a group of databases, extracting annotative information for the retrieved genes, followed by the assignment of the reference (or publication as in the instant claims) score to the extracted annotative information for the determination of the candidate gene.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

Inquiries

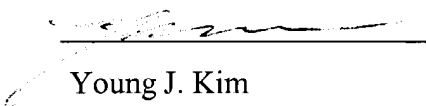
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner can normally be reached from 8:30 a.m. to 6:00 p.m. Monday through Thursday. If attempts to reach the Examiner by telephone are unsuccessful, the Primary Examiner in charge of the prosecution, Dr. Kenneth Horlick, can be reached at (571) 272-0784. If the attempts to reach the above Examiners are unsuccessful, the Examiner's supervisor, Gary Benzion, can be reached at (571) 272-0782. Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (703) 872-9306. For Unofficial

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documents, faxes can be sent directly to the Examiner at (517) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0507.



Young J. Kim
Patent Examiner
Art Unit 1637
6/3/04

yjk